

REMARKS

In the above Office Action claim 8 was rejected under §112, second paragraph for being indefinite and under 35 U.S.C. §103(a) for being obvious over Nagamoto in view of Official Notice. Now that claim 8 has been cancelled, these rejections are moot.

The Examiner also rejected claims 7 and 9-11 under 35 U.S.C. §103(a) for being obvious over U.S. Patent No. 5,904,628 to MacKay, Jr. et al., hereafter MacKay, view of U.S. Patent No. 6,287,214 to Satoh. The withdrawal of the rejection of these claims over Nagamoto is appreciated. However, it is believed they are also not obvious over MacKay and Satoh for the following reasons.

With respect to claim 7, the Examiner argues that Mackay, discloses a club head having an outer shell member, a hollow portion surrounded by the outer shell member, and a columnar neck member wherein an inner surface of the hollow portion includes a concave surface having no projecting portion formed thereon. The reference, however, does not show a columnar neck having an insertion hole for a shaft that is closed at the hollow portion side. On the other hand, since Satoh discloses that it is conventional to construct a columnar neck that is closed at the hollow portion referring to Fig. 6 and the Background Of The Invention portion of Satoh, he believes it would be obvious to do so.

However, while Fig. 6 in Satoh may illustrate an insertion hole for a neck of a golf club head that is closed at the hollow portion side, it is clearly seen that the neck partially projects into the hollow portion. This is different from the claimed golf club head and the one shown in Fig. 5 of the application, where none of the neck member projects into the hollow portion. Therefore, the limitation of "no projecting portion" in claim 1 is not shown by combining Satoh with MacKay. If such references are

combined, MacKay must include the structure of the neck member shown in Satoh and, if so, then it would project into the hollow portion of the golf club head.

In addition, the insertion hole of the neck member illustrated in Fig. 6 in Satoh has such a sharp edge that if MacKay was modified by Satoh, there would probably be damage to the bladder used in MacKay. Furthermore, in the present invention, as shown in Table 1 on page 18 of the specification, the golf club head of Comparative Example 1, in which the hosel has an edge at its end, has a notably high molding failure rate. Hence, one skilled in the art would have no motivation to combine Satoh with MacKay in the first place. But even if they were combined, such combination still does not teach the claimed invention.

As required by M.P.E.P. §2143.03, "all words in a claim must be considered in judging the patentability of that claim against the prior art." Moreover, as noted in M.P.E.P. §2143.02, to support a conclusion that a claim would have been obvious, "all the claimed elements" must have been known in the prior art. It is submitted that neither of these requirements have been met in the rejection of claim 7 over MacKay in view of Satoh, because when combined as suggested, they do not meet all of the claimed limitations.

Withdrawal of the rejection of claim 7 and claim 10 dependent therefrom under §103(a) over MacKay in view of Satoh is requested.

Regarding claim 9, this is drawn to a golf club instead of a golf club head and includes all of the same limitations as claim 7 as well as a grip and a golf club shaft. Accordingly, it is believed claim 9 and claim 11 dependent therefrom are patentable over the cited references for the same reasons.

It is believed claims 7 and 9-11 are in condition for allowance.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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